

REMARKS

Reconsideration and allowance of the application is respectfully requested. Claims 1-5 were in the application, claims 1, 2, 4 and 5 have been amended, claim 3 has been cancelled.

New claims 6-12 have been added, directed to additional features described on Page 4, L. 21-30, Page 6, L. 1-12.

Claims 1-5 were rejected under 35 U.S.C. §103(a) as being obvious over Hutton, U.S. Patent No. 5,440,479 in view of Cannon, U.S. Patent No. 5,056,029.

In order to uphold a finding of obviousness, there must be some teaching, suggestion or incentive for doing what the applicants have done. ACS Hospital Systems, Inc. v. Montefiore Hospital, 723 F.2d 1572 (Fed. Cir. 1984).

It is the claimed invention as whole, that must be considered in an obviousness determination, and the invention as a whole embraces the structure, its properties, and the problems it solves. Cable Elec. Prod. Inc. v. Genmark, Inc., 226 USPQ 881 (Fed. Cir. 1985); In re Reinhart 189 USPQ 143 (CCPA 1976).

The applicant's invention is directed to an automated system for the delivery of gifts specifically health care products. As discussed in the specification, such products were generally not considered suitable as gifts, having been presented solely for consumption by the purchaser. Further, the large variety of possible products and combinations made it difficult for one to select suitable health care products as gifts and would further require the sender to package them as a gift. (Page 3, L. 1-16)

The applicant's invention solved these problems and allowed these health care products to enter into a new market, where the products are purchased for delivery as gifts. The fact that there are unconventional gift products is part of what makes the system and method unique.

Neither of the references cited by the examiner teaches or suggests, or even hints that such products could or should be presented as gifts.

Hutton is directed to a floral kiosk system which is used to select and send flower arrangements.

Flowers are a conventional gift and Hutton merely ties into, with automation, an existing flower delivery network such as FTD® (Col. 5, L. 25-26).

Cannon is directed to greeting cards, another conventional item associated with gift giving. Again, there is no suggestion for using health care products as gifts, and nothing to lead one to the applicants' invention.

As there is nothing to teach or suggest the applicants' invention, claims 1, 2, 4 and 5 are not obvious and the rejection should be withdrawn.

Claim 3 was rejected as being obvious over Hutton and Cannon, in view of the website page. The limitation of claim 3 is now included in amended claim 1. However, the rejection is improper as the website page is not prior art to the claimed invention.

This application claims priority in provisional patent application number 60/242,636 filed October 23, 2000, which is substantially co-extensive in scope with the present application. The earliest date of the website is February, 2001, according to the "about us" page. Consequently, the rejection must be withdrawn.

Based upon the above amendments and remarks, favorable consideration and allowance of the application is respectfully requested. However, should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of this application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,



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